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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,907	09/05/2003	Valerie De La Poterie	05725.1236-00	6821

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WASHINGTON, DC 20001-4413

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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08/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/654,907	<b>Applicant(s)</b> DE LA POTERIE ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 79-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 79-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of remarks and IDS filed on 5/21/08. Receipt is also acknowledged of certified translated documents of provisional applications (There is no provisional application number identified on the covering letter).

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claims 1-24 and 79-107 are pending in the application. The claims will be examined to the extent that it reads on kesterwax 82 P (INCI name synthetic wax) and carnauba wax as the additional wax.

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1-24, 85-100, 102-107 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,875,245 ('245).
2. The filing date of the instant application is 9/5/03 since the provisional applications are in French.
3. See table 15 drawn to "transfer resistant mascara".
4. See claimed species, synthetic wax, and carnauba wax as the additional wax, bees wax is another wax claimed in claim, isododecane is the volatile oil, and alkyl silicone resin reads on the claimed film former. The weight percent disclosed in the example is within the claimed range for all the waxes, volatile oil and film former. Iron oxide reads on the additive (dye stuff) claimed in claim 102 and the example meets claim 103 since the composition does not have UV-screening agent. The wax claimed is same to that disclosed and therefore claims 2-9, 15-20 are

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also anticipated by patent. See paragraphs 31-33 for measuring the tack of wax. PTO is not equipped to measure the tack of wax; therefore patent anticipates claims 2-9 and 15-20.

***Response to Arguments***

Applicant's arguments filed 5/21/08 have been fully considered but they are not persuasive.

Applicants' argue:

“Applicants respectfully submit that the Examiner's reliance on Pavlin as § 102(e) prior art to the instant application is misplaced. In particular, Applicants' application claims priority to: U.S. Provisional Application No. 60/412,853, filed September 24, 2002; U.S. Provisional Application No. 60/418,345, filed October 16, 2002; U.S. Provisional Application No. 60/418,357, filed October 16, 2002; U.S. Provisional Application No. 60/412,854, filed October 16, 2002; U.S. Provisional Application No. 60/412,855, filed October 16, 2002; French Patent Application No. 02 11096, filed September 6, 2002; French Patent Application No. 02 11097, filed September 6, 2002; French Patent Application No. 02 11104, filed September 6, 2002; French Patent Application No. 02 12097, filed September 30, 2002; and French Patent Application No. 02 12098, filed September 30, 2002.

Thus, Applicants effective date of invention is no later than September 30, 2002. Pavlin was filed April 22, 2003, and published April 5, 2005. Pavlin is a continuation-in-part of U.S. Patent No. 6,552,160 ("the '160 patent"), filed on

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May 14, 2001. However, the subject matter used in the Examiner's rejection was not disclosed in the '160 patent. Specifically, the Examiner relies on Table 15 of Pavlin for the § 102(e) rejection (see Feb. 26, 2008, Office Action at 4-5), but this subject matter is not disclosed in the '160 patent. Thus, Pavlin's effective filing date is April 22, 2003, for purposes of the Examiner's § 102(e) rejection. Thus, the May 14, 2001, filing date cannot be relied upon for purposes of § 102(e) See M.P.E.P. § 2136.04(IV) ("[T]he subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).").

5. In response to the above argument, the filing date of the patent is **4/22/03** and the filing date of the instant application is **9/5/2003**. Applicants' are not accorded benefit of foreign priority document since the foreign priority documents are in French. Applicants' are not accorded benefit of provisional applications since the certified translated copies of provisional applications do not identify the provisional application number. Therefore 102 (e) rejection is deemed proper.

***Claim Rejections - 35 USC § 103***

6. Claims 1-24 and 79-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,875, 245 ('245).

7. Patent '245 as discussed above. Patent '245 teaches personal care products and teaches amphiphilic compound (surfactants), fatty phase, which includes claimed non-volatile oil, additives at col.15, line 50 through col.16 and teaches film forming polymers at col.19, lines 32

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through col.21, line 40 and teaches at col.21 line 41 through col.23, line 52 compositions that can be formulated as a mascara... hair care products (see col.23, ll 40-45). See also examples. Patent '245 thus teaches the limitations claimed in claims 89-92 and also 79-84 at col.21, line 56 through col.22, lines 1-3. See also examples for various cosmetic products.

8. Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions by using three waxes taught in table 15 and also add aqueous phase, surfactant, non-volatile oil into the compositions since patent '245 teaches that the compositions can also have these ingredients. This is a prima facie case of obviousness.

#### ***Response to Arguments***

Applicant's arguments filed 5/21/08 have been fully considered but they are not persuasive.

Applicants' argue:

“The Examiner's reliance on Pavlin as prior art is misplaced. For art to be relied upon under 35 U.S.C. § 103 as the basis for an obviousness rejection, the art must first qualify as prior art under the definition of 35 U.S.C. § 102. Here, however, for the reasons discussed above, Pavlin is not prior art under § 102(e), or any other section of § 102”.

9. In response to the above argument, the filing date of the patent is **4/22/03** and the filing date of the instant application is **9/5/2003**. Applicants' are not accorded benefit of foreign priority document since the foreign priority documents are in French. Applicants' are not accorded benefit of provisional applications since the certified translated copies of provisional

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applications do not identify the provisional application number. Therefore 103 rejection based upon 102 (e) is deemed proper.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1615

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